

AUG 25 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES
IN RE APPLICATION

OF: WITTELER ET AL.

CONFIRMATION No.: 2769

SERIAL No. 10/070,758

GROUP ART UNIT: 1615

FILED: MARCH 12, 2002

EXAMINER: B. M. FUBARA

FOR: PROCESS FOR PREPARING POLYVINYLPIRROLIDONE-IODINE IN
AQUEOUS SOLUTIONI hereby certify that this correspondence is being
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Honorable Commissioner
for Patents
P.O. Box 1450
Alexandria, VA 22313-1450REPLY BRIEF

Sir:

This is in reply to the Examiner's Answer dated June 27, 2005.

It is respectfully submitted that appellants stand by the position taken in their main Brief on Appeal that the teaching of *Denzinger et al.* (US 4,402,937) does not anticipate the invention defined in appellants' Claims 1 to 9 and 12 within the meaning of 35 U.S.C. §102(b). In the Examiner's Answer, the Examiner has in regard to that issue merely reiterated the position already taken in the final Office action of February 13, 2004. It is noted, however, that the Examiner conceded in the Examiner's Answer that the teaching of *Denzinger et al.* fails to exemplify the relationship between the concentration *c* and the Fikentscher *K* value which is required in accor-

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dance with appellants invention.¹⁾ Appellants therefore maintain their request that the Examiner's rejection of appellants' Claims 1 to 9 and 12 under 35 U.S.C. §102(b) be reversed.

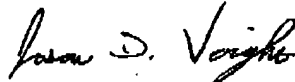
Additionally, the Examiner has introduced a new ground of rejection in the Examiner's Answer which had not been raised in the final action.²⁾ More particularly, the Examiner newly presented reasons why the subject matter of appellants' Claims 1 to 9 and 12 was unpatentable under the provisions of 35 U.S.C. §103(a) in light of the teaching of *Denzinger et al.* (ibid.). An Examiner's Answer may not raise a new issue unless an appellant submitted changes to the claims after the final action issued. Since appellants did not change their claims after the Examiner issued the final action, the Examiner's Answer is deemed to be inappropriate. In order to raise a new issue, the Examiner should have re-opened the prosecution and should have raised the new issue in a non-final action, thereby giving appellants due opportunity to fully and properly address such new issue.

It is therefore respectfully requested that the new issue be disregarded, or that the application be returned to the Examiner to properly raise the new issue in a non-final action. Favorable action is solicited.

Please charge any shortage in fees due in connection with the filing of this paper, including Extension of Time fees, to Deposit Account No. 14.1437. Please credit any excess fees to such deposit account.

Respectfully submitted,

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1) Cf. page 4 of the Examiner's Answer, last para., line 5.

2) Cf. pages 4 and 5 of the Examiner's Answer.

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